

REMARKS

The Examiner is respectfully requested to enter this Reply After Final in that it raises no new issues. Alternatively, the Examiner is respectfully requested to enter this Reply After Final in that it places the application in better form for Appeal.

Status of the Claims

Claims 16-28 are currently pending. Claims 1-15 have been cancelled. Claims 18-28 have been added. New claims 18-28 correspond to and are based on cancelled claims 3-9 and 12-15. No new matter has been added by the new claims.

Objection to Specification

The Examiner objects to the specification under 35 USC 132 for introducing new matter. Applicants traverse the objection and respectfully request the withdrawal thereof. Applicants cancel claim 1 which contained the term "nonpolymerizable". As such, the rejection is moot. Also, Applicants submit that the new claims do not contain the term "nonpolymerizable".

Rejection under 35 USC 112, first paragraph

The Examiner rejects claims 1-10 and 12-17 for containing subject matter that is not adequately described in the

specification. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants cancel claims which contain the term "nonpolymerizable". As such the rejection is moot. Also, Applicants submit that the new claims do not contain the offensive term.

Rejection maintained under 35 USC 102

The Examiner continues to reject claims 1-3 and 10 as anticipated by Kigawa (USP 5,798,434). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the instant invention is directed to a cosmetic or external agent comprising a dimerdiol ester of a monocarboxylic acid having 4 to 34 carbon atoms and/or a dimerdiol ester of a dicarboxylic acid. On the other hand, Kigawa '434 is directed to a polymer for plastic lenses and not directed to a cosmetic or external agent. Kigawa '434 does not contain the properties required for a cosmetic or external agent. For example, sensorial properties are not present in the polymer of Kigawa '434 and this property is needed in cosmetics.

As such, the present invention is patentable over Kigawa '434, as the instant invention is directed to a cosmetic or external agent and Kigawa is directed to a polymer for plastic lenses. In addition, one of ordinary skill in the art would not be motivated

by Kigawa '434, which teaches polymers for plastic lenses to arrive at the instant invention of a cosmetic or external agent. For the foregoing reasons, the rejection should be withdrawn.

Rejections maintained under 35 USC 103

The Examiner continues to reject claims 4-9 and 13-17 as obvious over Ansmann et al. (USP 5,795,978) in view of Harmann et al. (USP5,739,190), Akrongold et al. (USP 3,846,550) and Bernhardt et al. (USP 4,788,054) and further in view of Clum et al. (USP 5,652,263). Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants submit that the instant invention is patentable over Ansmann '978 in view of Harmann '190, Akrongold '550 and Bernhardt '054 and further in view of Clum '263. The instant invention is distinguishable over the combination of teachings. The significance of the present invention is in the dimerdiol ester of a specific carboxylic acid. This dimerdiol ester is very specific from among many known oil materials. For example, the dimerdiol ester used in the present invention exhibits higher effects than the other oil materials.

The specific dimerdiol ester of the present invention must be selected from various kinds of known oil materials. However, none of the cited references, Ansmann '978, Hartmann '190 and Akrongold '550, discloses or suggests the superiority of the

but they are in dependent claim
dimerdiol used in the present invention for cosmetics. Moreover,
none of the cited references discloses or suggests superiority
of the specific carboxylic acid of the instant invention for use
in cosmetics.

Applicants therefore submit that one of ordinary skill is not motivated to select dimerdiol and the specific carboxylic acid in combination to form the specific dimerdiol ester for use as an ingredient of a cosmetic or the like.

In particular, the Examiner cites Ansmann for dimer diol or trimer diol. However, col. 4, lines 39 to 56 disclose many kinds of oil materials. There is no particular attention or treatment of dimerdiol ester. In fact, as noted at col. 4, line 5, sensorial properties are not properties associated with oil materials including a dimerdiol ester. As such, Ansmann seems to teach away from the use of dimerdiol esters in cosmetics.

Ansmann is more concerned with triglycerides based on C₆-C₁₀ fatty acid. The dimerdiol ester of the instant invention has superior properties over the triglycerides based on C₆-C₁₀ fatty acid.

See comparative example 2 in the specification where glyceryl tri-2-ethylhectate is among the triglycerides based on C₆-C₁₀ fatty acid and the table on page 41 in the specification.

The Examiner also relies on Hartmann for aliphatic dicarboxylic acid esters and polyglycerol fatty acid ester. However, there is no motivation to one of ordinary skill in the

cosmetic arts to use the disclosure of Hartmann and apply it to Ansmann. Applicants submit that the Examiner is using impermissible hindsight to reconstruct the instant invention. The Examiner merely relies on Applicants' own teachings to form the obviousness rejection. The Examiner has taken the instant invention and divided it into two parts, i.e. a dimerdiol ester and a carboxylic acid. The Examiner has allegedly found each part in a separate reference. However, neither reference suggests combining the two to arrive at the instant invention. Such hindsight reconstruction is impermissible according to MPEP 2141 and In re Deminski, 796 F.2d 436, 443 230 USPQ 313, 316 (Fed. Cir. 1986). Furthermore, Hartmann does not suggest using the oils in cosmetics. Thus, one of ordinary skill would not be motivated to combine the carboxylic acid with the dimerdiol to form a dimerdiol ester for use in cosmetics or the like.

The Examiner also relies on Akrongold for disclosing esters of fatty acids as oils contained in cosmetic skin powder. However, Akrongold also discloses many other materials such as fatty acids, fatty alcohols and other oils. (See, Column 1, line 49 to Column 2, line 84.) Akrongold neither discloses nor suggests the superiority of the esters of fatty acids as compared to the other oils disclosed in Column 1, line 49 to Column 2, line 4. The dimerdiol ester of the present invention, a kind of ester of fatty acids, exhibits higher effects than the

other oil materials disclosed in Akrongold. For example, Caster oil is disclosed at line 64. See comparative Example 18 and comparative example 6, along with the Table at page 44 of the specification where Caster oil is used in comparative example 6.

Applicants submit that one of ordinary skill in the art would not be motivated to arrive at the instant invention from the teachings of Akrongold in combination with Ansmann since the superiority of esters of fatty acids and of the fatty acid used for producing the esters is not disclosed or suggested.

For the foregoing reasons, Applicants respectfully request that the obviousness rejection be withdrawn as Applicants have demonstrated that one of ordinary skill in the art would not be motivated to arrive at the instant invention from the combination of the disclosures.

Conclusion

As Applicants have addressed and overcome all objections and rejections in the Office Action by amendment and argument, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview

in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

Pursuant to the provisions of 37 C.F.R. § 1.17 and 1.136(a), Applicants hereby petition for an extension of one (1) month to December 13, 2001 for the period in which to file a response to the outstanding Office Action. The required fee of \$110.00 is attached hereto.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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Attachment: Version with Markings to Show Changes Made

(Rev. 09/26/01)

VERSION WITH MARKINGS TO SHOW CHANGES MADE



Claims 18-28 are added.

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